

REMARKS

Claims 1-9, and 13-25 are pending in the application.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-9, 16, and 20-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Markowitz et al., U.S. Patent No. 6,311,185 B1 (hereinafter “Markowitz”) in view of Yu, U.S. Patent No. 6,067,552 (hereinafter “Yu”). Claims 13-15 and 17-19 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Markowitz in view of Yu.

Applicants respectfully request reconsideration of the rejection in view of the following arguments.

On pages 17-20 (paragraphs 9-14), the Office Action provides a Response to Arguments section prepared in view of Applicants’ Amendment of August 3, 2004. In paragraph 10, the Office Action points to Col. 3, lines 2-12 that state in part “if a user has previously requested a large number of Web pages related to sports, an advertisement for a sporting good store might be selected ...” and additionally adds that “[t]he fact that a sport-related advertisement is selected for a sport web page inherently shows that the advertisement selection in Markovitz is based on the content of the requested web page and the content of the advertisement.” Applicants respectfully disagree.

The cited section is the only section of the Markowitz reference that refers to this “sporting good store ad” feature. The other sections of the reference cited in the Office Action pertain to physical attributes of a web-page, which the Examiner agrees are not related to content of a web-page. In particular, the description at Col. 1, lines 32-42, refers to a manual process (not an automatic process) where the content provider selects which ads are to be placed in Web pages to be downloaded through an ISP and a user. Col. 2, lines 60-64 refer to the standard

loading of a web-page and Col. 3, line 60 to col. 4, line 19 merely states that an appropriate advertisement is selected from a repository and placed within the HTML code of the requested web page.

There is little disclosure other than at the top of Col. 3, which is cited repeatedly in the Office Action. The “history database” of this section appears to store a list of web-sites that have been visited by the user. The Office Action appears to agree, in paragraph 12 that this would be the content of the history database. Thus, if a history database includes a list of web-sites (i.e., Uniform Resource Locators) such as “www.uspto.gov” and “www.espn.com,” then the only information available is the text of the URL and not the content of a web-site pointed to by the URL text. Such text is typically generated manually by a programmer and may or may not be related to the content of the web-page to which the URL refers. Given the text of the URLs, how is the content of these Web pages determined in Markowitz? Markowitz is completely silent on this point.

Thus, the Office Action appears to inappropriately supplement the disclosure of Markowitz in order to reach the claim limitations. In addition to the lack of disclosure as to how the content of a Web page is determined one can also ask other questions. How is the content of an advertisement determined? How is the content of a Web page compared to the content of an advertisement? None of these questions are answered by the Markowitz reference. Thus, Markowitz fails to teach the features of the presently claimed invention as contended in the Office Action.

The Yu reference does not make up for the deficiencies of Markowitz as described in Applicants’ previous remarks. Accordingly reconsideration and withdrawal of the rejection of claims 1-9 and 13-24 under 35 U.S.C. § 103(a) is respectfully requested.

CONCLUSION

For all the above reasons, the Applicant respectfully submits that this application is in condition for allowance. A Notice of Allowance is earnestly solicited.

The Examiner is invited to contact the undersigned at (408) 975-7500 to discuss any matter concerning this application. The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,
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